

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q80995
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed
	10/826,255	April 19, 2004
	First Named Inventor	
	Yuichiro UCHIGAKI	
	Art Unit	Examiner
	2178	Omar R. Abdul-Ali
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>		
<p>Applicant requests review of the final rejection in the above-identified Application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number 51,361</p> <p style="text-align: right;">/Ruthleen E. Uy/ Signature</p> <p style="text-align: right;">Ruthleen E. Uy Typed or printed name</p> <p style="text-align: right;">(202) 293-7060 Telephone number</p> <p style="text-align: right;">August 18, 2008 Date</p>		

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q80995

Yuichiro UCHIGAKI, et al.

Appln. No.: 10/826,255

Group Art Unit: 2178

Confirmation No.: 9402

Examiner: Omar R. Abdul-Ali

Filed: April 19, 2004

For: BROWSER APPARATUS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated March 18, 2008 and the Advisory Action mailed July 17, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal. Applicant turns now to the rejections at issue:

Claims 1-8 are all the claims pending in the application.

I. Rejection of claims 1, 2, 5, 6, and 8 under 35 U.S.C. § 103

Claims 1, 2, 5, 6, and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0107043 (hereinafter "de Silva") in view of U.S. Patent No. 7,206,599 (hereinafter "Lemley"). Applicants respectfully submit the following in traversal.

Regarding claim 1, the Examiner associates the enter key of de Silva with the "command input means" of claim 1, and the up/down keys of de Silva with the "shift direction input means" of claim 1. The Examiner also associates the scroll mode and zoom mode of de Silva with the "plurality of operation modes" recited in claim 1. The Examiner concedes, however, that de Silva does not disclose assigning different functions to said command input means depending on the mode of said browser apparatus" and cites Lemley to cure the deficiencies. *See* Final Office Action pg. 3 (emphasis in original); see also Advisory Action pg. 2.

Lemley discloses that during navigation mode, the ENTER key automatically functions to select a menu option or to enter input data rather than to "send" a telephone number dialed.

Further, the END key functions as a “back” key rather than as an “end” key to end a telephone call. However, the operation modes disclosed in Lemley are a navigation mode or alphanumeric (e.g. telephone call) mode. *See* Lemley col. 3 lines 36-67. Alphanumeric mode, which is the default mode, allows the user to dial telephone numbers. Lemley col. 3 lines 36-38. Navigation mode allows access to menu-driven options. Lemley col. 3 lines 43-44. The ENTER and END keys have one of two functions, and the specific function only depends on whether the user has pressed the toggle key 22. Applicant respectfully submits that simply pressing a toggle key does not amount to “manipulating a page displayed on a display means,” as recited in claim 1. Moreover, Applicant submits that the function of the ENTER and END keys are fixed and **independent** and do not teach that “the mode of said browser apparatus **as functions of manipulating the page displayed on said display means**,” as recited in claim 1.

Lemley does not disclose that the control means has a plurality of operation modes, and assigns different functions to said shift direction input means and said command input means depending on the mode of said browser apparatus in each of the plurality of operation modes as functions of manipulating the page displayed on said display means. Further, the modes disclosed in Lemley (a navigation mode or alphanumeric mode) are not different modes of a browser apparatus as claimed. Further, there is no teaching or suggestion of manipulating the page displayed on said display means.

Regarding the combination of de Silva and Lemley, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), *cited in* M.P.E.P. § 2143.01 (VI). An explicit object of de Silva is to “**simplify** an overall operation procedure of the navigation system.” *See* de Silva ¶¶ [0020]-[0021] (emphasis added). However, Lemley discloses that, “[a]s mobile designs advance, **more features are offered** to the user,” suggesting that the object of newer mobile devices is to provide increased functionality to consumers. *See* Lemley col. 1 lines 34-35 (emphasis added). Lemley further discloses that “[t]he present invention **increases the number of functions** that a given key on a mobile keypad performs.” *See* Lemley col. 2 lines 1-4 (emphasis added). Applicants respectfully submit that increasing functionality changes the principle of operation of de Silva, which aims to simplify operation,

because increased functionality would **complicate** the overall operation procedure of the navigation system in de Silva.

The Examiner maintains in the Advisory Action that de “Silva teaches a unique key arrangement having a minimum number of keys, and adding functionality to the number of keys would increase operator efficiency in the sense that the operator would not have to navigate to additional screens to perform desired functions.” AA pg. 2. However, the invention of de Silva is intended to provide “a unique key arrangement **having a minimum number of keys.**” *See* de Silva ¶ [0001] (emphasis added). As a consequence of the minimal number of keys in de Silva, adding more functionality to the same limited number of keys would tend to decrease operator efficiency. The more functions that a single key provides, for example, the more functions have to be scrolled through, as in de Silva, to select the desired function. Therefore, adding functionality does not necessarily increase operator efficiency.

The Examiner states that de Silva does not teach the claimed menu mode and cites Jeoung to cure the deficiency. However, Applicants respectfully submit that de Silva does not teach a surf mode either. As discussed above with respect to claim 1, de Silva discloses **a scroll mode and a zoom mode**. However, a scroll mode or a zoom mode does not teach a surf mode as would be apparent to one of skill in the art. Specifically, the scroll mode or zoom mode of de Silva does not select part of the page by moving a mouse cursor displayed on said display means in response to the shift command from said shift direction input means as claimed.

The Examiner contends that “de Silva discloses the surf mode feature with the teaching of a cursor that is moved around the screen to make selections of destinations.” AA pg. 2. Applicant respectfully submits that, on the contrary, de Silva discloses a **stationary** cursor that is displayed **at the center of the screen**. *See* de Silva ¶ [0014]. This cursor is **not moved** around the screen, but rather “[w]hen the user finds a particular street which goes to the particular destination, he **adjusts the map image so that the cursor 51 specifies the street image.**” *See* de Silva ¶ [0014]. As can be seen in Figures 3A-3G and 7A-23B of de Silva, the cursor/marker is stationary, and is only found at the center of the screen. In addition, the aspects of de Silva cited by the Examiner disclose the operation of the scroll mode or the zoom mode and not a surf mode as claimed.

In addition, the combination of Jeoung with de Silva is not obvious. Specifically, modes of de Silva merely change a direction or zoom-in and zoom-out of a vehicle route page.

However, there is no teaching or suggestion of a menu mode and operation within a menu mode which would require the selection of menu items on a displayed menu. Specifically, this would require a substantial modification of the principle of operation of de Silva evidencing that the Examiner's reasoning is merely a result of impermissible hindsight.

For at least the above reasons, Applicants respectfully submit that claim 1 and its dependent claims should be deemed allowable.

Regarding claim 5, claim 5 recites "wherein said command input means comprises an enter key for starting processing, and a back key for making transition of the operation mode." The Examiner asserts that the "cancel" key of de Silva teaches the claimed back key and that the "enter" key of de Silva teaches the claimed enter key. However, contrary to the Examiner's assertions, de Silva does not teach an "enter" key and "cancel" key as claimed. Specifically, the center key on three button device 120 acts as the "enter" key and "cancel" key. *See* de Silva page 6, para. [0070]. Applicants respectfully submit that de Silva does not teach two keys for performing the "enter" command and the "cancel" command. Therefore, de Silva does not teach command input means comprising an enter key for starting processing, and a back key for making transition of the operation mode, as claimed. Consequently, Applicants respectfully submit that claim 5 should be deemed allowable.

Regarding claim 8, Applicants respectfully submit that de Silva and Lemley do not disclose a "browser apparatus ... wherein said enter key and said back key **comprise separate keys** on said command input means." Specifically, de Silva and Lemley may not be combined for at least the reasons submitted above for claim 1.

Further, as motivation for using Lemley to cure the deficiencies of de Silva, the Examiner asserts that "[o]ne would have been motivated to use a separate enter key and back key **to provide dedicated keys for separate functions.**" *See* Final Office Action pg. 5 (emphasis added). However, as discussed above, de Silva teaches away from using dedicated keys for separate functions because "an object of [de Silva is] to provide ... **a minimum number of keys** ..., thereby simplifying an overall operation procedure of the navigation system." *See* de Silva ¶ [0021] (emphasis added). Further, de Silva explicitly states that it is preferable that the key arrangement is configured by three buttons mounted on a steering wheel, thereby promoting easy operation and safe driving. *See* de Silva ¶ [0024]. For at least these reasons, Applicants respectfully submit that claim 8 should be deemed allowable.

II. Rejection of claims 3 and 4 under 35 U.S.C. § 103

Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over de Silva in view of Lemley and further in view of U.S. Patent No. 6,799,061 (hereinafter “Jeoung”). Applicants respectfully submit the following in traversal. Claims 3 and 4 should be deemed allowable at least by virtue of their dependency from claim 1.

Regarding claim 4, the Examiner asserts that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a cross key in Silva.” See Final Office Action at pg. 6. The Examiner states that “[o]ne would have been motivated to include a cross key for design choice.” See Final Office Action pg. 6.

It is well known that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396, quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), cited in M.P.E.P § 2143.01 (IV). In other words, Applicants respectfully submit that the Examiner’s proffered motivation for combining de Silva and Jeoung does not meet the minimum legal standard for *prima facie* obviousness. Moreover, as discussed above, the additional functionality of a cross key would add a complexity which is contrary to the operation of de Silva. For at least the above reasons, Applicants respectfully submit that claim 4 should be deemed allowable.

III. Rejection of claim 7 under 35 U.S.C. § 103

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over de Silva in view of U.S. Patent No. 6,487,495 (hereinafter “Gale”). Applicants respectfully submits that claim 7, which is dependent from independent claim 1, is patentable at least by virtue of its dependency from claim 1.

Respectfully submitted,

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